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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/687,545	10/15/2003	Christopher H. Porter	355492-4200	7701
38706	7590	01/31/2006		
FOLEY & LARDNER LLP 1530 PAGE MILL ROAD PALO ALTO, CA 94304			EXAMINER JONES, DAMERON LEVEST	
			ART UNIT 1618	PAPER NUMBER

DATE MAILED: 01/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.



## ACKNOWLEDGMENTS

1. The Examiner acknowledges receipt of the following: (1) the amendment filed 3/12/04 wherein the specification was amended; (2) the amendment filed 6/10/04 wherein claim 3 was amended; (3) the amendment filed 10/20/05 wherein claims 19-24 were canceled.

**Note:** Claims 1-18 are pending.

## APPLICANT'S INVENTION

2. The instant invention is directed to compositions and uses thereof wherein the composition comprises a prepolymeric material and a rheological modifier.

## RESPONSE TO APPLICANT'S ELECTION

3. Applicant's election with traverse of Group II (claims 1-18) filed 10/12/05 is acknowledged. The traversal is on the ground that searching the full scope of the instant invention would not be a burden on the Examiner. This is found non-persuasive because the inventions are separate and distinct. A search of one group would neither anticipate nor render obvious another group. Hence, searching the full scope of the instant invention would be burdensome to the Examiner. Thus, the restriction requirement are still deemed proper and is therefore made FINAL.

**Notes:** It is duly noted that Applicant elected the species wherein the prepolymeric material is 2-hydroxyethyl methacrylate; the rheological modifier is fumed silica; the contrast agent is tantalum; the thickening agent is carboxymethyl cellulose;

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the plasticizer is glycerol esters; the radioactive agent is 125iodine; the surfactant is Tween; and the medicament is a thrombotic agent. The search was not further expanded because prior art was found which could be used to reject the instant invention. Claims 1-7, 9-11, and 14-18 read on the elected species.

#### **WITHDRAWN CLAIMS**

4. Claims 8, 12, and 13 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention/species.

#### **DOUBLE PATENTING REJECTIONS**

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422

F.2d 438, 164 USPQ 619 (CCPA 1970); and In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1-7, 9-11, and 14-18 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 3, 4, 6, 7, 10-13, 15, 16, and 21-25 of copending Application No. 10/686,929. Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims are directed to compositions comprising a polymeric material and a rheological modifier. The claims differ in that those of 10/686,929 requires the presence of a non-reactive biocompatible substance, a rheological modifier, a biocompatible liquid, and a contrast agent while the instant invention only requires the present of a biocompatible liquid and a contrast agent. Thus, it would be obvious to one of ordinary skill in the art that both the instant invention and that of

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10/686,929 disclose overlapping subject matter. Furthermore, it is noted that both the instant invention allows for additional components to be present in the composition.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### 103 REJECTIONS

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-7, 9-11, and 14, 15, 17, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Patterson et al (US 2004/0224864).

**Patterson et al** disclose sterilize embolic compositions that may be administered to a subject via a catheter and may comprise a contrast agent, prepolymer, and optionally thickeners and/or rheological modifiers for diagnostic and therapeutic purposes (see entire document, especially, abstract; page 2, paragraph [0030]; and pages 2-3, bridging paragraph). Peterson et al also disclose that the one may use thickeners and/or rheological modifiers since both the thickener and modifier act to enhance the static viscosity such that the flow properties of the composition under static conditions is significantly reduced (page 2, paragraph [0030]). In another embodiment,

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the composition comprises (1) a biocompatible polymer; (2) a biocompatible solvent; (3) optionally, a biocompatible water insoluble contrast agent; and (4) a fumed silica or other hydroxyl containing theological modifier (page 3, paragraph [0048]). The method of embolizing a vascular site in a mammal comprises delivering the composition via a catheter (page 3, paragraph [0051]). Possible modifiers include carboxymethylcellulose (page 7, paragraph [0117]). Possible biocompatible contrast agents include water insoluble contrast agents such as tantalum, tantalum oxide, gold, tungsten, platinum, and barium sulfate. Likewise, water soluble contrast agents such as lipidol and metrizamide may be utilized (page 8, paragraphs [0129] and [0130]). A possible biocompatible prepolymer is hydroxyethyl methacrylate (page 9, paragraph [0140]). In addition, surfactants (i.e., Tween) and biocompatible plasticizers which Patterson et al disclose that the particular plasticizer employed is not critical (page 10, paragraphs [0147] and [0148]). On page 11, paragraph [0173], Patterson et al disclose that other combinations besides silica, ethylene vinyl alcohol copolymer, DMSO, and tantalum may be utilized. Hence, it would have been obvious to one of ordinary skill in the art at the time the invention was made to generate a composition comprising a rheological modified and a prepolymeric material because both Applicant and Patterson et al disclose compositions comprising such components.

## COMMENTS/NOTES


9. Applicant is not entitled to the date of the provisional application, 60/418,251 filed 10/15/02, because one could not locate each component as set forth in the instant

invention. If Applicant is in disagreement with the Examiner, it is respectfully requested that Applicant point to page(s) and line number(s) wherein support may be found for the instant invention.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. L. Jones whose telephone number is (571) 272-0617. The examiner can normally be reached on Mon.-Fri., 6:45 a.m. - 3:15 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Hartley can be reached on (571) 272-0616. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
D. L. Jones  
Primary Examiner  
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January 23, 2006